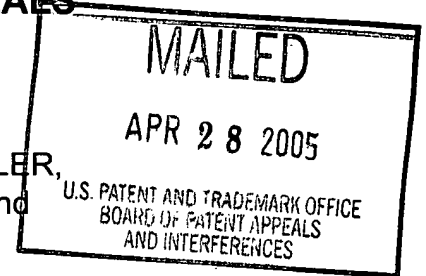


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte HEINRICH GERS-BARLAG, ANJA MULLER,
XENIA PETSITIS, GHITA LANZENDORFER, and
MELANIE KOVACEVIC



Appeal No. 2005-0592
Application No. 09/640,822

ON BRIEF

Before WILLIAM F. SMITH, ELLIS, and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 16-31. Claims 16 and 29 are representative of the subject matter on appeal, and read as follows:

16. Cosmetic or dermatological stick preparation, which is a finely disperse water-in-oil emulsion, comprising:

a) an oil phase which

comprises from 10 to 70% by weight, based on the weight of the oil phase, of fatty and/or wax components which melt above a temperature of 40°C,

b) a water phase,

c) at least one modified phyllosilicate pigment particles which exhibit both hydrophilic and lipophilic properties, which thus has amphiphilic character and positions itself at the water/oil interface, and

d) at most 0.5% by weight, based on the total weight of the preparations, of one or more emulsifiers.

29. Method for the preparation of Pickering emulsion sticks, wherein modified phyllosilicate pigment particles are dispersed in the oil phase, which comprises from 10 to 70% by weight, based on the weight of the oil phase, of fatty and/or wax components which melt above a temperature of 40°C, and, optionally, cosmetic or pharmaceutical auxiliaries, additives and/or active ingredients, with uniform stirring and optionally with heating, and, during the uniform stirring, the water phase, which, optionally comprises cosmetic or pharmaceutical auxiliaries, additives and/or active ingredients, is mixed with the oil phase.

The examiner relies upon the following references:

Fänger et al. (Fänger)	6,153,204	Nov. 28, 2000
Msika et al. (Msika)	5,939,054	Aug. 17, 1999

Claims 16-31 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Fänger and Msika. After careful review of the record and consideration of the issues before us, we reverse.

BACKGROUND

According to the specification,

The present invention relates to cosmetic or pharmaceutical sticks which are in the form of W/O [water-in-oil] emulsions and

which are characterized by an increased water content. In particular, the invention relates to decorative lipsticks and lipcare sticks, but also to deodorizing or antiperspirant sticks, and to stick formulations which are suitable, for example, for use against acne. As further advantageous embodiments, the present invention relates to sunscreen sticks and so-called make-up or cosmetic sticks, such as, for example, eyebrow pencils, kohl pencils, eyeshadow pencils, eyeliner pencils, concealer sticks, powder sticks and comparable products.

Specification, page 1.

DISCUSSION

Claims 16-31 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Fänger and Msika.

Fänger is cited for teaching cosmetic or pharmaceutical preparations having a reduced feeling of stickiness. The preparations are emulsifier-free, water-in-oil lipodispersions, and the reference also teaches that the preparation may be in the form of a stick, such as a lipstick or a deodorant stick. Fänger is also cited for teaching the use of aluminum silicates, such as bentonites, as thickeners for use in the preparation. See Examiner's Answer, page 3.

According to the examiner, "[t]he reference lacks preferred modified hectorites and methods of preparing the emulsions." Id. at 4.

Msika is cited for teaching water-in-oil sunscreen emulsions in the form of sticks, wherein quaternium 14 and 18 hectorites are taught as gelling agents for use in the emulsions. The reference is also cited for teaching that the aforementioned gelling agents optimize the stability of the water-in-oil emulsions and potentiate the solar protection in the highest protection factors. See id.

The Answer concludes:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify the instant water-in-oil emulsions using the teachings of [Fänger] because [Fänger] teach[es] emulsifier-free, water-in-oil emulsions comprising oily phase constituents that melt above 40 C and teach aluminum silicate (a phyllosilicate) as a thickener for use in the emulsion, wherein the emulsion can be in the form of a lipstick; hence, using the teachings of [Fänger] to arrive at the instant invention.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the quaternium-18 hectorite of [Msika] for the aluminum silicate in [Fänger] because of the expectation of optimizing the stability of water-in-oil emulsions and of potentiating the solar protection of the emulsion, and because the replacement of one phyllosilicate gelling agent for the other, for cosmetic thickening purposes, would be within the skill of one in the art.

Id. at 4-5.

Appellants argue that the examiner has used hindsight to arrive at the claimed invention. See Appeal Brief, page 6. According to appellants, “[t]here is no recognition that Fänger’s cosmetic or topical dermatological preparation would simultaneously have the elements of appellants’ invention (e.g. (1) stick preparation; (2) water-in-oil emulsion; (3) modified phyllosilicate pigment with amphiphilic character; (4) at most 0.5% by weight of one or more emulsifiers).”

Id.

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant.” In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir.

1993) (citations omitted). The test of obviousness is “whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention.”

In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

Fänger only teaches the use of phyllosilicate pigment particles, such as bentonites, as thickeners in hair preparations in the form of gels. Specifically, Fänger teaches at column 10, lines 15-27, (emphasis added),

For the purposes of the present invention, cosmetic preparations for the treatment and care of the hair can be in the form of gels which, in addition to an effective content of active ingredient[s] according to the invention and solvents which are used therefor, preferably water, also contain organic thickeners . . . or inorganic thickeners, e.g., aluminum silicates, such as, for example, bentonites, or a mixture of polyethylene glycol and polyethylene glycol stearate or distearate.

Thus, the examiner has not considered the Fänger reference in its entirety, see In re Kuderna, 426 F.2d 385, 389, 165 USPQ 575, 578 (CCPA 1970) (noting that obviousness is determined in view of the sum of all of the relevant teachings in the art, not isolated teachings in the art); see also In re Shuman, 361 F.2d 1008, 1012, 150 USPQ 54, 57 (CCPA 1966), and has read the teaching of Fänger that phyllosilicate pigment particles, such as bentonites, may be used as thickeners, out of context. Moreover, the examiner does not provide any teaching or suggestion from either the Fänger reference or the Msika reference for using phyllosilicate pigment particles as thickeners in a stick

stick preparation as required by the claims.¹ Consequently, the rejection must be reversed.

OTHER MATTERS

We note that there appears to be an information disclosure statement, submitted November 12, 2003, that was not considered during the prosecution of the application. Upon return of the application, the disclosure statement should be considered.

CONCLUSION

Because the rejection of claims 16-31 under 35 U.S.C. § 103(a) over the combination of Fanger and Msika does not set forth a prima facie case of obviousness, it is reversed.

REVERSED


William F. Smith

Administrative Patent Judge



Joan Ellis

Administrative Patent Judge



Lora M. Green

Administrative Patent Judge

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¹ We note that the recitation of a “[c]osmetic or dermatological stick preparation” occurs in the preamble of claims 16 and 31, the independent composition claims. The recitation of “stick” in the preamble is “necessary to give life, meaning and vitality to the claims,” and thus is a limitation of the claimed preparation. Kropa v. Robie, 858 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1991).

Norris, McLaughlin & Marcus, PA
220 East 42nd Street
30th Floor
New York, NY 10017